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Paula S. Newman

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PAULA S. NEWMAN

Appeal 2009-000347
Application 09/732,023
Technology Center 2400

Before JOHN A. JEFFERY, ST. JOHN COURTENAY III, and
STEPHEN C. SIU, *Administrative Patent Judges*.

SIU, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

This is a decision on appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1-35. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

Invention

The invention relates to the display of information in mail folder displays (Spec. 1, ll. 3-4).

Independent claim 1 is illustrative:

1. A method for displaying an e-mail collection, the e-mail collection including a plurality of e-mail messages assigned to one or more categories and subcategories, the method comprising:

defining a display specification to specify a manner in which e-mail messages assigned into each of the categories and subcategories are to be displayed in a top-level representation, comprising each of:

specifying a plurality of category-specific arrangements of e-mail messages in differing levels of granularity that are specific to the categories and subcategories to which the e-mail messages are assigned;

specifying a plurality of display-specific arrangements of e-mail messages in differing levels of granularity that are specific to the display to which the e-mail messages are assigned; and

specifying a plurality of layouts of the category-specific arrangements and the display-specific

arrangements that are specific to the display upon which the e-mail messages are displayed; and displaying each of the e-mail messages in accordance with the display specification using the category-specific arrangement and the display-specific arrangement for the category or subcategory to which the e-mail message is assigned, and using the layout for the display upon which the e-mail message is displayed.

References

The Examiner relies upon the following references as evidence in support of the rejection:

Macleod Beck	US 6,170,011 B1	Jan. 2, 2001 (filed Nov. 12, 1998)
Raghunandan	US 6,832,244 B1	Dec. 14, 2004 (filed Sep. 21, 2000)

Bill Dyszel, *Microsoft Outlook 2000 for Windows for Dummies*, Wiley Publishing, Inc., Hoboken, NJ, pp. 84-85, 156, 158 (1999) (“Dyszel”).

Rejections

Claims 1, 2, 5, 7-9, 12, 14-17, 20, 22-28, 30-33, and 35 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Raghunandan and Dyszel.

Claims 3, 4, 6, 10, 11, 13, 18, 19, 21, 29, and 34 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Raghunandan, Dyszel, and Macleod Beck.

ISSUES

Issue 1

The Examiner finds that it would have been obvious to an artisan to combine the teachings and suggestions of Raghunandan and Dyszel “for the purpose of saving a lot of time when you’re trying to find things on the email” (Ans. 14).

Appellant argues that “[o]ne of ordinary skill in the art would not find a suggestion or motivation to combine Raghunandan with Dyszel” (App. Br. 9).

Issue: Did the Examiner err in finding that it would have been obvious to an artisan to combine the teachings and suggestions of Raghunandan and Dyszel?

Issue 2

Appellant argues that “[t]he Raghunandan-Dyszel combination does not allow either display-specific arrangements in differing levels of granularity or a plurality of layouts of category-specific arrangements and display-specific arrangements that are specific to the display upon which the e-mail messages are displayed” (App. Br. 11).

The Examiner finds that “Applicant argument is vague” (Ans. 14).

Issue: Did the Examiner err in finding that Raghunandan and Dyszel would have taught or suggested specifying a plurality of category-specific arrangements of e-mail messages in differing levels of granularity that are specific to the categories and subcategories to which the e-mail messages are assigned, specifying a plurality of display-specific arrangements of email

messages in differing levels of granularity that are specific to the display to which the e-mail messages are assigned, and specifying a plurality of layouts of category-specific arrangements and display-specific arrangements that are specific to a display upon which e-mail messages are displayed?

Issue 3

The Examiner finds that Dyszel “discloses displaying each of the e-mail messages in accordance with the display specification, using the category-specific arrangement and the display-specific arrangement for the category or subcategory to which the e-mail message is assigned, and using the layout for the display upon which the e-mail message is displayed” (Ans. 14-15).

Appellant argues that “Raghunandan discloses multiple types of e-mail classifications, including sender names, sender domain, e-mail subject, contained keywords, e-mail size, e-mail attachments, and date sent or received. Dyszel permits specification of categories and shunting of messages into these categories” (App. Br. 11) (citation omitted). Appellant further argues that “the Raghunandan-Dyszel combination teaches *away* from displaying e-mail in differing levels of granularity” (*id.*).

Issue: Did the Examiner err in finding that Raghunandan and Dyszel would have taught or suggested displaying each of a set of e-mail messages in accordance with a display specification, using a category-specific arrangement and a display-specific arrangement for the category or subcategory to which the e-mail message is assigned, and using the layout for the display upon which the e-mail message is displayed?

Issue 4

The Examiner finds that it would have been obvious to an artisan to combine the teachings and suggestions of Raghunandan, Dyszel, and Macleod Beck because “such a system would maximize agent efficiency and increase potential enterprise profitability” (Ans. 15).

Appellant argues that “no suggestion or motivation to combine Macleod Beck with Raghunandan and Dyszel has been shown, as there is no need taught or suggested by Raghunandan-Dyszel to bring in multimedia capability as taught by Macleod Beck” (App. Br. 22).

Issue: Did the Examiner err in finding that it would have been obvious to an artisan to combine the teachings and suggestions of Raghunandan, Dyszel, and Macleod Beck?

Issue 5

The Examiner finds that “Macleod Beck discloses an email encapsulated into threads” (Ans. 11).

Appellant argues that “Macleod Beck teaches a dynamic multimedia threading wherein text is linked to multimedia” (App. Br. 23). Appellant further argues that “the Macleod Beck and Raghunandan-Dyszel combination does not allow static text-only threading” (*id.*).

Issue: Did the Examiner err in finding that Raghunandan, Dyszel, and Macleod Beck would have taught or suggested a display specification that provides that the e-mail messages in at least one of a plurality of categories and subcategories are encapsulated into threads, and that the top-level display of the entire e-mail collection includes one item from each thread?

FINDINGS OF FACT

The following Findings of Fact (FF) are shown by a preponderance of the evidence.

1. Raghunandan teaches that

parsed emails are identified based on combinations of various parameters such as keywords/phrases/sender/subject/domain, as defined in the configuration data. After identification, the emails of the same type are grouped together (10), as defined by the configuration information and the email groups are then sequenced in a priority sequence, defined by the configuration data. Finally, the emails are displayed (11) on the display device by graphical output generator (4), which converts each email into a graphical symbol, such as a button, in accordance with the configuration data supplied by the user.

(Col. 6, ll. 54-65).

2. Raghunandan provides “a sample graphical output of [an e-mail display]” (col. 7, l. 14; fig. 3), along with “part of the configuration data [for the display]” (col. 7, l. 15):

Sample Parameters	Colour of button	Icon/Symbol/Letter
All Mails from John Smith	Red	Smiley
All Mails from John Smith with keyword “Rate”	Green	% (Percent symbol)
All Mails from John Smith with keyword “Work”	Pink	
...

(Col. 7, ll. 19-23).

3. Dyszel teaches, as part of “E-Mail and Contacts: Not Just Playing Post Office,” that “[i]f the predefined group views don’t meet your needs, you can group items according to just about anything you want, assuming that you’ve entered the data” (p. 158), noting that “[g]rouping is a good way to manage all Outlook items, especially contacts” (*id.*).
4. Dyszel teaches that “[i]f you group by too many columns, your list will be harder rather than easier to use” (p. 85).
5. Macleod Beck discloses that “a system known to the inventors provides for keeping accurate records of all communication center interactions in . . . threaded multimedia-contact histories” (col. 4, ll. 38-40).
6. Macleod Beck illustrates “a customer 205 as having two threads . . . issue I and issue II” (col. 22, ll. 49-50; fig. 8). Each thread is depicted as including E-mail Text (225, 239), Fax Text (227, 233), WEB text (229, 237), and V-Phone Text (231) (fig. 8).
7. Macleod Beck teaches that a “TXT (text) viewer may only be able to view e-mails from the user and agent in a specific interaction thread, but not intermittent e-mails on the thread that may be from agent to agent or supervisor to agent and so on” (col. 27, l. 66 – col. 28, l. 3).

PRINCIPLES OF LAW

Claim interpretation

“In the patentability context, claims are to be given their broadest reasonable interpretations. . . . [L]imitations are not to be read into the claims from the specification.” *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993) (citations omitted). Any special meaning assigned to a term “must be sufficiently clear in the specification that any departure from common usage would be so understood by a person of experience in the field of the invention.” *Multiform Desiccants Inc. v. Medzam Ltd.*, 133 F.3d 1473, 1477 (Fed. Cir. 1998).

Obviousness

The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results,” *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 416 (2007), especially if the combination would not be “uniquely challenging or difficult for one of ordinary skill in the art,” *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007) (citing *KSR*, 550 U.S. at 418).

“A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from

the path that was taken by the applicant.” *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994). “Obviousness does not require absolute predictability of success. . . . There is always at least a possibility of unexpected results For obviousness . . . all that is required is a reasonable expectation of success.” *In re O’Farrell*, 853 F.2d 894, 903-04 (Fed. Cir. 1988) (citations omitted).

ANALYSIS

Issue 1

Appellant challenges the Examiner’s finding that it would have been obvious to combine the teachings and suggestions of Raghunandan and Dyszel. Based on Appellant’s arguments in the Appeal Brief, we will decide the appeal of claims 1-35 with respect to issue 1 on the basis of claim 1. *See* 37 C.F.R. § 41.37(c)(1)(vii).

We are not persuaded by Appellant’s arguments, which fail to show error in, or even address, the Examiner’s rationale that an artisan would combine the references “for the purpose of saving a lot of time when you’re trying to find things on the email” (Fin. Rej. 4). Furthermore, both Raghunandan and Dyszel teach or suggest e-mail grouping (FF 1, 3). Thus, we agree with the Examiner that it would have been obvious to an artisan possessing creativity and common sense to combine teachings and suggestions from these related references.

Appellant further argues that “Dyszel teaches *away* from Raghunandan by teaching that grouping by too many categories will make using the list more difficult rather than easier to use” (App. Br. 10). “A

reference may be said to teach away when a person of ordinary skill, upon [examining] the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.” *Para-Ordnance Mfg., Inc. v. SGS Importers Int’l, Inc.* 73 F.3d 1085, 1090 (Fed. Cir. 1995) (quoting *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994)). While Dyszel teaches grouping by too many columns makes a list harder to use (FF 4), this would only discourage one from using Dyszel’s grouped display with too many groupings. Appellant does not offer arguments or evidence to show the Examiner’s combination of Raghunandan and Dyszel requires grouping by too many columns. Thus, Appellant fails to show why an artisan would have been discouraged from combining teachings and suggestions from Raghunandan and Dyszel.

Appellant also argues that combining Raghunandan and Dyszel would “provide displaying e-mail messages in graphical form, organized by categories, which could require scrolling to see all e-mails in the screen” (App. Br. 10). Appellant argues that “having to scroll graphical images may lead to confusion or delay in responding to important e-mails” (*id.*) (emphasis added), and thus “there would not be a reasonable expectation of success” (*id.*). However, Appellant only argues that a possible combination of Raghunandan and Dyszel could provide a suboptimal solution. Appellant does not demonstrate that such a solution would be a failure or that an artisan would not have had a reasonable expectation of success in combining the teachings and suggestions of Raghunandan and Dyszel.

For at least these reasons, we find no evidence persuasive of error in the Examiner's 35 U.S.C. § 103(a) rejection of claim 1, and claims 2-35 which fall therewith with respect to this issue.

Issue 2

Appellant challenges the Examiner's finding that Raghunandan and Dyszel would have taught or suggested the claimed specifying limitations. Based on Appellant's arguments in the Appeal Brief, we will decide the appeal of claims 1-35 with respect to issue 2 on the basis of claim 1. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Raghunandan teaches a graphical e-mail display in which e-mail messages are categorized based on a parameters with different levels of specificity (e.g., All Mails from John Smith vis-à-vis All Mails from John Smith with keyword "Rate") (FF 2). Raghunandan further teaches that these categories are linked with a color (such as red, green, or pink) and an optional icon, symbol, or letter (such as a smiley or a percent symbol) (*id.*). Dyszel teaches an e-mail display with both predefined group views and a user defined group view (FF 3). Therefore, Raghunandan and Dyszel would have taught or suggested specifying a plurality of category-specific arrangements (parameters to categorize) of e-mail messages in different levels of granularity (with different levels of specificity) that are specific to the categories and subcategories to which the e-mail messages are assigned, specifying a plurality of display-specific arrangements (colors and icons/symbols/letters) of email messages in differing levels of granularity (where icons/symbols/letters are optional) that are specific to the display to which

the e-mail messages are assigned, and specifying a plurality of layouts (predefined and user defined group views) of category-specific arrangements and display-specific arrangements (with parameters, colors, and optional icon/symbols/letters) that are specific to a display upon which e-mail messages are displayed.

Appellant recites the limitations that the category-specific arrangements, the display-specific arrangements, and the layouts are specific to a display upon which e-mail messages are displayed (App. Br. 10-11). However, Appellant fails to provide arguments or evidence to demonstrate that these limitations are not taught or suggested by Raghunandan and Dyszel. Moreover, Appellant neither discusses this limitation in explaining the claimed subject matter nor provides citations to illustrate any special meaning that an artisan would find clear (App. Br. 4-6). Therefore, we find no error in the Examiner's finding that these limitations also would have been taught or suggested by Raghunandan and Dyszel.

For at least these reasons, we find no evidence persuasive of error in the Examiner's 35 U.S.C. § 103(a) rejection of claim 1, and claims 2-35 which fall therewith with respect to this issue.

Issue 3

Appellant argues that combining the teachings and suggestions of Raghunandan and Dyszel would have taught away from the displaying limitation. Based on Appellant's arguments in the Appeal Brief, we will decide the appeal of claims 1-35 with respect to issue 3 on the basis of claim 1. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Appellant argues that “Raghunandan and Dyszel still teach a one-dimensional display of e-mail messages that will not add more granularity when displayed across multiple displays” (App. Br. 12). However, Appellant does not identify claim language that links granularity with the number of displays used.

Appellant further argues that “the three-dimensional e-mail display of category-specific, display-specific, and layout-specific dimensions would not be predictable to one skilled in the art, which would require looking beyond one-dimensional e-mail displays, as taught and suggested by both Raghunandan and Dyszel” (*id.*). This argument is unpersuasive because the combination of Raghunandan and Dyszel would have taught or suggested at least three dimensions of e-mail display (parameters, colors, icons/symbols/ letters, and group views).

For at least these reasons, we find no evidence persuasive of error in the Examiner’s 35 U.S.C. § 103(a) rejection of claim 1, and claims 2-35 which fall therewith with respect to this issue.

Issue 4

Appellant challenges the Examiner’s finding that it would have been obvious to combine the teachings and suggestions of Raghunandan, Dyszel, and Macleod Beck. Based on Appellant’s arguments in the Appeal Brief, we will decide the appeal of claims 3, 4, 6, 10, 11, 13, 18, 19, 21, 29, and 34 with respect to issue 4 on the basis of claim 3. *See* 37 C.F.R. § 41.37(c)(1)(vii).

As discussed above, the combined teachings and suggestions of Raghunandan and Dyszel would have taught or suggested email display using categories, displays, and layouts. Macleod Beck teaches e-mails encapsulated in threads (FF 5, 6).

Appellant argues that “there is no need taught or suggested by Raghunandan-Dyszel to bring in multimedia capabilities as taught by Macleod Beck” (App. Br. 22). However, Appellant fails to address the Examiner’s rationale that combining the teachings and suggestions of Raghunandan-Dyszel with Macleod Beck “would maximize agent efficiency and increase potential enterprise profitability” (Fin. Rej. 11). Furthermore, Appellant fails to show why the combination of Raghunandan-Dyszel with Macleod Beck is anything more than a predictable combination of familiar elements to yield predictable results (an e-mail display with e-mail encapsulation).

For at least these reasons, we find no evidence persuasive of error in the Examiner’s 35 U.S.C. § 103(a) rejection of claim 3, and claims 4, 6, 10, 11, 13, 18, 19, 21, 29, and 34 which fall therewith with respect to this issue.

Issue 5

Appellant argues that the combination of Raghunandan, Dyszel, and Macleod Beck would have failed to teach or suggest text-only threading. Based on Appellant’s arguments in the Appeal Brief, we will decide the appeal of claims 3, 10, and 18 with respect to issue 5 on the basis of claim 3. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Appellant's arguments regarding static text-only threading are not persuasive because the claims do not recite static text-only threading. Claim 3, for example, encompasses "[t]he method of claim 1, wherein the display specification provides that the e-mail messages in at least one of the plurality of categories and subcategories are encapsulated into threads, and that the top-level display of the entire e-mail collection includes one item from each thread."

Furthermore, Macleod Beck teaches or suggests threads containing text items, including email (FF 5, 6), and a text viewer for perusing those threads (FF 7). Therefore, we find no error in the Examiner's conclusions that the teachings and suggestions of Raghunandan, Dyszel, and Macleod Beck would have taught or suggested a display specification (taught or suggested by Raghunandan and Dyszel) that provides that the e-mail messages in at least one of a plurality of categories and subcategories are encapsulated into threads (threads including e-mail text), and that the top-level display of the entire e-mail collection includes one item from each thread (displayed in a text viewer).

For at least these reasons, we find no evidence persuasive of error in the Examiner's 35 U.S.C. § 103(a) rejection of claim 3, and claims 10 and 18 which fall therewith with respect to this issue.

CONCLUSIONS OF LAW

Based on the findings of facts and analysis above, we find no evidence persuasive of error in the Examiner's findings:

1. that it would have been obvious to an artisan to combine the teachings and suggestions of Raghunandan and Dyszel (issue 1);
2. that Raghunandan and Dyszel would have taught or suggested specifying a plurality of category-specific arrangements of e-mail messages in differing levels of granularity that are specific to the categories and subcategories to which the e-mail messages are assigned, specifying a plurality of display-specific arrangements of email messages in differing levels of granularity that are specific to the display to which the e-mail messages are assigned, and specifying a plurality of layouts of category-specific arrangements and display-specific arrangements that are specific to a display upon which e-mail messages are displayed (issue 2);
3. that Raghunandan and Dyszel would have taught or suggested displaying each of a set of e-mail messages in accordance with a display specification, using a category-specific arrangement and a display-specific arrangement for the category or subcategory to which the e-mail message is assigned, and using the layout for the display upon which the e-mail message is displayed (issue 3);
4. that it would have been obvious to an artisan to combine the teachings and suggestions of Raghunandan, Dyszel, and Macleod Beck (issue 4); and
5. that Raghunandan, Dyszel, and Macleod Beck would have taught or suggested a display specification that provides that the e-mail messages in at least one of a plurality of categories and subcategories are encapsulated

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into threads, and that the top-level display of the entire e-mail collection includes one item from each thread (issue 5).

DECISION

We affirm the Examiner's decisions rejecting claims 1-35 under 35 U.S.C. § 103(a).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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